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REMARKS

Claims 1-22 are pending in the present Application, with claims 20-22 withdrawn from consideration. Claims 1 and 13 have been amended, Claim 3 has been canceled, and no claims have been added, leaving Claims 1, 2, and 4-19 for consideration upon entry of the present Amendment.

Claim 1 has been amended to include the limitation "wherein the article comprises a textured exterior surface over at least a portion thereof, wherein the textured exterior surface comprises the thermoplastic resin and the bioicidal inorganic agent." Support for this amendment can at least be found in Claim 3 as originally filed.

Claim 13 has been amended to correct a typographical error. Support for this amendment can at least be found in Claim 13 as originally filed as well as in Paragraph [0090] as originally filed.

No new matter has been introduced by these amendments or new claims. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Double Patenting

Claims 1-19 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/797975. Applicants respectfully request that the Examiner withdraw the "provisional" obviousness-type double patenting rejection until the claims are in final form and condition for allowance; until such time, there is no double patenting and no way to determine double patenting. MPEP § 804(D)(3)(1).

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-19 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 6,365,066 to Podszun, et al. Applicants respectfully traverse this rejection.

In the present Amendment, the claims have been amended to include the limitation that the article comprises "a textured exterior surface."

The Examiner has stated that "in view of substantially identical composition of the film

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and film thickness disclosed in Podszun et al. and as claimed, the examiner has a reasonable basis to believe the claimed biocidal metal release property, the exterior surface and texture properties, the biocidal activity, and the growth reduction to be inherent in the compositions of Podszun et al.” (Office Action dated December 19, 2005 at page 5). Applicants respectfully disagree.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). The Examiner concedes that the cited reference does not teach four claim limitations while, at the same time, states that the reference anticipates the present invention by inherency. However, anticipation by inherency requires that the anticipating elements (1) are necessarily present and (2) one of ordinary skill in the art recognize or appreciate the inherent element. “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Furthermore, “in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); MPEP § 2112.

The present claims are directed to an article having a textured exterior surface that effectively releases biocidal metals from the exterior surface of the article. As disclosed in the Examples of the present Application, the textured exterior surface improves the biocidal metal release properties of the article. Claims 1-5 of the present application are further directed to an article comprising an inorganic biocidal agent wherein the article has a biocidal metal release factor greater than 2.5. The biocidal coating of the present claims can therefore advantageously reduce the growth of pathogenic organisms due to the effective release of biocidal metals.

Podszun et al., in contrast, is directed to antifouling coatings that are applied to articles in contact with sea water to prevent infestation (i.e., attachment and growth) of algae and other marine organisms. (Abstract, Col. 1, ll. 57-59) Podszun et al. fail to teach or suggest an article

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having a textured exterior surface, the specific biocidal metal release properties, or killing of *E. coli* or *Staphylococcus aureus*, as required by the present claims. The Examiner appears to rely upon the allegedly "substantially identical composition of the film and film thickness disclosed in Podszun et al." as the basis in fact and/or technical reasoning to support the determination that these allegedly inherent characteristics necessarily flow from the teaching of Podszun et al.

Applicants respectfully submit that at least a textured surface is not an inherent feature of an identical or substantially identical film because an additional modification is required to provide a textured surface. There is no teaching or suggestion of such a modification in Podszun et al. As disclosed in the present application, a substantially identical film demonstrably fails to possess a textured exterior surface as required by the present claims and consequently fails to exhibit the specific biocidal metal release properties, or killing of *E. coli* or *Staphylococcus aureus*, as required by the present claims. The article of the present application is modified by texturizing an exterior surface to provide the claimed textured exterior surface, which results in the claimed biocidal metal release properties. (§ [0017]). The unmodified (i.e., non-textured) surface corresponds to the Examples of the present Application which are labeled "As such." As shown in Table 2, of the present Application, the textured surface improves metal release. For example, an article comprising 5 wt% of Agion AJ80II, texturizing improved the metal release by greater than 10-fold. Also, as shown in Table 6 of the present Application, the textured surfaces exhibit high biocidal efficacy indicating effective biocidal metal release properties. For example, an article comprising 0.5 wt% of biocidal agent Irgaguard B5021 (Sample W) is over one hundred fold more effective with a textured surface than without. (Tables 5 and 6). All the samples in Table 6 similarly demonstrate that texturizing a surface provides a one to two log improvement in biocidal efficacy.

The compositions of Podszun, which are allegedly substantially identical in composition, do not provide a textured exterior surface. The Podszun compositions also do not provide the specific biocidal metal release properties, and the effective killing of *E. coli* or *Staphylococcus aureus*. A characteristic cannot be inherent in, i.e., necessarily flow from, a prior art composition, if the prior art composition, even if identical, would require an additional modification. Because a textured surface is not taught or suggested by Podszun et al., Podszun et al. cannot anticipate the presently claimed invention.

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For at least the forgoing reasons, reconsideration and withdrawal of the rejection under 35 U.S.C. 102(a) is requested.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-19 also stand rejected as allegedly obvious under 35 U.S.C. § 103(a) over Podszun et al. Applicants respectfully traverse this rejection.

As described above Podszun et al. fail to disclose an article comprising a textured exterior surface as required by the present claims. Further, there is no teaching or suggestion in Podszun et al. that texturing the surface of an article can lead to improved biocidal activity, thus this reference does not provide the motivation to texture an article as claimed in the present application. As stated above, the Examiner appears to be relying on inherency for the present rejections.

It is respectfully submitted that the Examiner has inappropriately used inherency in putting forth a rejection under 35 U.S.C. § 103(a). The courts have repeatedly made the distinction that "the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 150 U.S.P.Q. 449, 452, (CCPA, 1966), citing *In re Adams*, 53 CCPA 996, 356 F.2d 998, 148 U.S.P.Q. 742. "Further it confuses anticipation by inherency, i.e., lack of novelty, with obviousness, which though anticipation is the epitome of obviousness, are separate and distinct concepts." *Jones et al. v. Hardy*, 220 U.S.P.Q. 1021, 1025 (CCPA, 1984) citing *In re Pearson*, 494 F.2d 1399, 181 U.S.P.Q. 641 (CCPA, 1974); *In re Oelrich*, 666 F.2d 578, 212 U.S.P.Q. 323 (CCPA, 1981). "The examiner should be aware that inherency and obviousness are distinct concepts." *Ex parte GPAC Inc.*, 29 U.S.P.Q.2d 1401, 1415, n. 15, citing *In re Naylor*, 369 F.2d 765, 152 U.S.P.Q. 106 (CCPA 1966); *In re Henderson*, 348 F.2d 550, 146 U.S.P.Q. 372 (CCPA 1965). "The theory of inherency is normally reserved for rejections under 35 U.S.C. § 102." *In re Grasselli*, 318 U.S.P.Q. 303 (Fed. Cir. 1983).

Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly,

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reconsideration and withdrawal of the rejections and allowance of the case are respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-3621.

Respectfully submitted,

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